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PATENT AGENT
ALLEN C. YUN, PH.D.

SENT TO: Ms. Margaret W. Stevens

DATE SENT: April 13, 2000

SUBJECT: Wallach; Appln No. 08/485,129; Our WALLACH=5B

No. of pages (including this cover sheet): 7

FROM: Roger L. Browdy

Remarks:

Attached hereto is your decision of March 6, 2000, about which we discussed by telephone today. Also attached is some source material that makes abundantly clear that one does not have to pay two appeal fees in a case which has not yet gone to the Board of Patent Appeals and Interferences. The commentary in the rulemaking of 37 CFR 1.129 is directly on point.

Please call me if you have any questions. If you agree that your original decision was in error, please send me another decision refunding the second appeal fee erroneously charged to our account.

Thank you.

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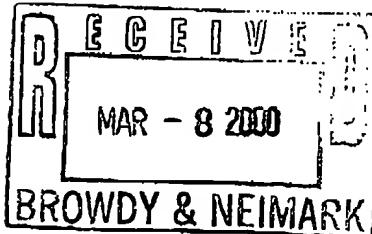
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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231**

March 6, 2000

Browdy and Neimark
419 Seventh Street, N.W.
Washington, D.C. 20004



In re applicant: David Wallach
 Serial No. 08/485,129
 Filing Date : 06/07/95
 For : Isolated DNA Encoding Tumor Necrosis Factor Binding Protein II, And Vectors, Hosts And Processes Using Such DNA : Response To Request For Refund

This is in response to your letter submitted October 26, 1999, wherein you requested a refund of \$300.00 in the above identified application.

- () Small entity status fee not refundable. The time has expired for refund of this fee. A refund based on establishment of small entity status may only be obtained if a verified statement under 37 CFR 1.27 and a request for refund of the excess amount are filed within two months of timely payment of the full fee (37 CFR 1.28).
- () Application or petition fee not refundable. Money paid by actual mistake or in excess, such as payment not required by law, will be refunded; a mere change of purpose after payment of money, as when a party desires to withdraw an application, an appeal or a request for oral hearing does not entitle the party to refund (37 CFR 1.26). If any application is filed without the specification or drawing and the omission is not corrected within the period set, the application will be returned or otherwise disposed of. The fee, if submitted should include the \$130.00 handling fee (37 CFR 1.53).
- (X) Other: No refund is due. The Notice of Appeal and the fee for filing an appeal filed on November 3, 1997 was filed in response to the Final Rejection mailed July 2, 1997. The Notice of Appeal was necessary to maintain pendency in the above-identified application.

Any inquiry regarding this letter should be addressed to Margaret Stevens on 703-305-3608 or FAX number 703-308-7922.

The Office regrets the delay in responding to your letter

Margaret W. Stevens
 Margaret W. Stevens
 Supervisory Legal Instrument Examiner
 Technology Center 1600/2900

Arizona SHPO agreed with OSM's determination that no aspects of the proposed amendment pertain to cultural or historic resources (administrative record No. NA-239). As such, the Arizona SHPO determined that the amendment would have no effect on cultural resources under the National Historic Preservation Act of 1966 and 36 CFR part 800.

(b) *Navajo Nation Historic Preservation Department.*

By letter dated February 21, 1995, the Department agreed with OSM's determination that the proposed changes to the Navajo Nation AMLR Code of 1987 do not pertain to cultural resources. Therefore, it stated that the amendment will have no effect on cultural resources (administrative record No. NA-237).

(c) *U.S. Bureau of Indian Affairs.* The Bureau of Indian Affairs stated in a memorandum dated March 13, 1995, that a technical review had been completed by its Area Real Estate Services, Rights Protection Section, and that it had no comments (administrative record No. NA-238).

VI. Director's Decision

Based on the above findings, the Director approves the Navajo Nation's proposed plan amendment as submitted on January 12, 1995, and as revised on February 23, 1995.

As discussed in finding No. 1, the Director approves nonsubstantive revisions to the Navajo Nation AMLR Code of 1987 at sections 404(a) and (c), eligible lands and water.

As discussed in finding No. 2, the Director approves substantive revisions to the Navajo Nation AMLR Code of 1987 at section 404(b), reclamation of interim program coal sites.

The Director approves the proposed revisions of the Navajo Nation AMLR Code of 1987 with the provision that they be fully promulgated in identical form to the code submitted to and reviewed by OSM and the public.

The Federal regulations at 30 CFR part 756, codifying decisions concerning the Navajo plan, are being amended to implement this decision. This final rule is being made effective immediately to expedite the Tribal plan amendment process and to encourage Tribes to bring their plans into conformity with the Federal standards without undue delay. Consistency of Tribal and Federal standards is required by SMCRA.

VII. Procedural Determinations

1. Executive Order 12866

This rule is exempted from review by the Office of Management and Budget

(OMB) under Executive Order 12866 (Regulatory Planning and Review).

2. Executive Order 12778

The Department of the Interior has conducted the reviews required by section 2 of Executive Order 12778 (Civil Justice Reform) and has determined that this rule meets the applicable standards of subsections (a) and (b) of that section. However, these standards are not applicable to the actual language of State or Tribal AMLR plans and revisions thereof since each such plan is drafted and promulgated by a specific State or Tribe, not by OSM. Decisions on proposed State or Tribal AMLR plans and revisions thereof submitted by a State or Tribe are based on a determination of whether the submittal meets the requirements of Title IV of SMCRA (30 U.S.C. 1231-1243) and the applicable Federal regulations at 30 CFR parts 884 and 888.

3. National Environmental Policy Act

No environmental impact statement is required for this rule since agency decisions on proposed State or Tribal AMLR plans and revisions thereof are categorically excluded from compliance with the National Environmental Policy Act (42 U.S.C. 4332) by the Manual of the Department of the Interior (516 DM 6, appendix 8, paragraph 8.4B(29)).

4. Paperwork Reduction Act

This rule does not contain information collection requirements that require approval by OMB under the Paperwork Reduction Act (44 U.S.C. 3507 et seq.).

5. Regulatory Flexibility Act

The Department of the Interior has determined that this rule will not have a significant economic impact on a substantial number of small entities under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.). The Tribal submittal which is the subject of this rule is based upon Federal regulations for which an economic analysis was prepared and certification made that such regulations would not have a significant economic effect upon a substantial number of small entities. Accordingly, this rule will ensure that existing requirements established by SMCRA or previously promulgated by OSM will be implemented by the Tribe. In making the determination as to whether this rule would have a significant economic impact, the Department relied upon the data and assumptions in the analyses for the corresponding Federal regulations.

List of Subjects in 30 CFR Part 756

Abandoned mine land reclamation program, Indian lands.

Dated: April 19, 1995.

Charles E. Sandberg,

Acting Assistant Director, Western Support Center.

For the reasons set out in the preamble, Title 30, Chapter VII, Subchapter E of the Code of Federal Regulations is amended as set forth below:

PART 756—INDIAN TRIBE ABANDONED MINE LAND RECLAMATION PROGRAMS

1. The authority citation for part 756 continues to read as follows:

Authority: 30 U.S.C. 1201 et seq. and Pub. L. 100-71.

2. Section 756.14 is amended by adding paragraph (c) to read as follows:

§ 756.14 Approval of amendments to the Navajo Nation's Abandoned Mine Land Plan.

(c) Revisions to sections 404 (a), (b), and (c) of the Navajo Nation Abandoned Mine Land Reclamation (AMLR) Code of 1987, pertaining to eligible lands and water, as submitted to OSM on January 12, 1995, and as subsequently revised on February 23 1995, are approved effective April 25, 1995.

[FR Doc. 95-10169 Filed 4-24-95; 8:45 am]
BILLING CODE 4310-05-M

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1 and 3

[Docket No. 950404087-5087-01]

RIN 0651-AA76

Changes To Implement 20-Year Patent Term and Provisional Applications

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Patent and Trademark Office (PTO) is amending the rules of practice in patent cases to establish procedures for: filing and processing provisional application papers; calculating the length of any patent term extension to which an applicant is entitled where the issuance of a patent on an application filed on or after June 8, 1995 (the implementation date of the 20-year patent term provisions of the Uruguay Round Agreements Act), other

a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c).

92. Comment: One comment asked (1) whether it would be necessary to file a Notice of Appeal and appeal fee with or after the first submission and fee if the examiner acts on the first submission and before the end of the six months from the date of the final rejection issues (a) a notice of allowance, (b) a non-final action, or (c) a second final rejection; (2) would the Notice of Appeal and fee be due only at the end of the six months from the date of the final rejection regardless of whether the examiner has acted on the submission by then; and (3) if the Notice of Appeal and fee have once been paid following a first final rejection, would a second notice and fee need to be paid if a second final rejection were issued and applicant desired to file a second submission under § 1.129(a).

Another comment suggested that the appeal fee set forth in § 1.17(e) should not be required where the Notice of Appeal is filed with a § 1.129(a) submission and the fee set forth in § 1.17(r).

Response: As to questions (1) and (2) and the second comment, if the first submission and the proper fee set forth in § 1.17(r) are timely filed in response to the final rejection, the finality of the previous rejection will be automatically withdrawn and applicant need not file the Notice of Appeal or the appeal fee. For example, if the first submission and the proper fee set forth in § 1.17(r) were filed on the last day of the six-month period for response to the final rejection, applicant must also file a petition for three months extension of time with the appropriate fee in order to avoid abandonment of the application. In such case, applicant need not file the Notice of Appeal or the appeal fee if the proper fee set forth in § 1.17(r) was timely paid. However, under the same fact situation, if applicant failed to submit the proper fee set forth in § 1.17(r), the finality of the previous rejection would not be withdrawn and the time period for response would still be running against applicant. In such case, a Notice of Appeal and appeal fee must also accompany the papers filed at the six-month period in order to avoid abandonment of the application. The proper fee set forth in § 1.17(r) must be filed prior to the filing of the Appeal Brief and prior to the abandonment of the application.

As to question (3), if the Notice of Appeal and fee have once been paid

following a first final rejection and applicant timely files a first submission and the proper fee set forth in § 1.17(r), the finality of the previous final rejection will be withdrawn and the appeal fee paid could be applied against any subsequent appeal. If the examiner

issues a non-final rejection in response to applicant's first submission, a further response from applicant will be entered and considered as a matter of right. If any subsequent Office action is made final, applicant may file a second submission along with the proper fee pursuant to § 1.129(a). If the second submission and the proper fee set forth in § 1.17(r) are timely filed in response to the subsequent final rejection, the finality of the previous final rejection will be withdrawn. Any submission filed after a final rejection made in the application subsequent to the fee under § 1.129(a) having been paid twice will be treated as set forth in § 1.116. Applicant may, upon payment of the appeal fee, appeal a final rejection within the time allowed for response pursuant to § 1.191.

93. Comment: One comment questioned whether the "first submission" under § 1.129(a) has to be the first response filed after a final rejection or could it include subsequent responses to the same final rejection.

Response: The "first submission" under § 1.129(a) would include all responses filed prior to and with the payment of the fee required by § 1.129(a) provided the submission and fee are filed prior to the filing of the Appeal Brief and prior to abandonment of the application.

94. Comment: One comment suggested that § 1.129(a) be changed to permit the procedure to be available up until the filing of an Appeal Brief since it is not uncommon to file an amendment after a Notice of Appeal is filed but before the filing of an Appeal Brief.

Response: The suggestion has been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

95. Comment: One comment suggested that the transitional after-final practice be available at any time after final, including after the resolution of an appeal unfavorable to applicant in whole or in part.

Response: The suggestion has not been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the

application. The suggestion to extend the period to after the resolution of an appeal unfavorable to applicant in whole or in part has not been adopted because the suggestion would further unduly extend prosecution of the application.

96. Comment: One comment stated that if an examiner must withdraw the finality of the rejection as a result of the transitional provision, the examiner should be credited with two counts in order to be compensated for the additional work.

Response: The examiner credit system is not part of this rulemaking package. However, as part of the Public Law 103-465 implementation plan, some accommodation will be made for the extra work performed.

97. Comment: One comment stated that regarding the transitional after-final practice, the fee should not be required if the only reason is to have the PTO consider recently obtained art.

Response: Under current practice, if applicant submits prior art after final rejection but before the payment of issue fee, the art will be considered if applicant makes the required certification and submits a petition with the required petition fee of \$130.00 (see section 609 of the MPEP). If applicant can make the certification, applicant would not have to rely on the transitional after-final procedure to have the prior art considered. In the event that applicant cannot make the certification, then the procedure under § 1.129(a) is available if applicant wishes the PTO to consider the prior art without refiling the application.

98. Comment: One comment suggested that the PTO modify existing restriction practice to make it more difficult for examiners to require restriction, for example, by requiring every restriction requirement to show two-way distinctness and separate status in the art established by means other than reference to the PTO's classification system.

Response: The suggestion has not been adopted. However, the PTO is undertaking a project to reengineer the entire patent process. This suggestion will be taken under advisement in that project.

99. Comment: One comment suggested that the pendency periods required by §§ 1.129(a) and (b) should be 18 months rather than 2-year and 3-year, respectively.

Response: The pendency periods set forth in the rule which establish eligibility for the transitional procedures are set forth in Public Law 103-465.

100. Comment: One comment suggested that § 1.129(a) be amended to

846 O.G. 693 March 29, 1967

Practice Re: Withdrawal of Final Rejection by the Examiner After Notice of Appeal to the Board of Appeals

Where Notice of Appeal to the Board of Appeals has been filed and the Examiner withdraws the final rejection for allowance or further rejection, applicants are reminded that this results in automatic removal of the appeal from the records of the Board of Appeals in that application.

Accordingly, a proper response to a subsequent final rejection requires the filing of a new Notice of Appeal [without fee] and if this appeal is carried forward, the appropriate fee on filing a brief in support of the second appeal is required.

SOURCE MATERIAL FOR NEW RULES EFFECTIVE DECEMBER 1, 1997**QUESTIONS AND ANSWERS****QUESTIONS AND ANSWERS* *(1)****CHANGES TO PATENT PRACTICE AND PROCEDURE -- FINAL RULE****Effective Date: December 1, 1997**

***Editor's Note:** The following Questions and Answers are presented in composite form. This material includes:*

- (1) original Q&As (Q1-Q148, except where revised), dated October 8, 1997, which were included in the Training and Implementation Guide and were made available to the public through the Internet on the USPTO web site;*
- (2) revised Q&As (Q15, Q16, Q24, Q28, Q31, Q32, and Q75), dated March 3, 1998, which reflect the amendment of 37 C.F.R. § 1.53(d) to no longer require that a prior application of a Continued Prosecution Application (CPA) be filed on or after June 8, 1995 (See Changes to Continued Prosecution Application Practice, 63 Fed. Reg. 5,732 (February 4, 1998)); and*
- (3) new Q&As (Q149-Q170), dated March 3, 1998, which supplement existing topical areas.*

Appeal Process Changes (*Continued from Q119*)

(Q161) An examiner reopens prosecution after a first appeal brief has been filed.

Part I – Will appellant need to pay a second notice of appeal fee or a second appeal brief fee when a second appeal results from the reopening of prosecution?

Answer: No. Where the Board of Patent Appeals and Interferences (BPAI) has not rendered a substantive decision on the merits in the first appeal, neither a second notice of appeal fee nor a second appeal brief fee will be required.

Part II – Is the answer to Part I dependent upon whether appellant elects to continue prosecution before the examiner or requests reinstatement of the appeal under 37 C.F.R. § 1.193(b)(2)(ii)?

Answer: No. Whether appellant elects to continue prosecution or requests reinstatement of the appeal will not affect the need to file a second fee. No additional appeal fee or appeal brief fee shall be due where no BPAI decision has been rendered.

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